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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/915,719

07/25/2001

James A. Parker

6795

26362 7590 01/30/2007  
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EXAMINER

MANIWANG, JOSEPH R

ART UNIT

PAPER NUMBER

2144

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/30/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/915,719

Applicant(s)

PARKER, JAMES A.

Examiner

Joseph R. Maniwang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27,29-33,37,38 and 44-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 and 44-48 is/are allowed.
- 6) ☒ Claim(s) 15-19,21-27,29-32,49,53 and 54 is/are rejected.
- 7) ☒ Claim(s) 20,33,37,38 and 50-52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/07/06.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 53 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. The term "properly programmed" in claim 53 is a relative term which renders the claim indefinite. The term "properly programmed" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:  
  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 26, 27, 53, and 54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. Regarding independent claim 26, "An apparatus comprising: (1) a transmission medium forming at least part of a computer network; and (2) a data stream in the

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transmission medium of the network, the data stream encoding a series of data frames, the frames comprising: (a) reference data...; (b) a message recipient frame; (c) a file viewer frame...; and (d) a file editor frame..." is non-statutory. The claimed "transmission medium" can be reasonably interpreted by one of ordinary skill in the art as intangible transmission mediums common within the art (e.g., electromagnetic signals, carrier waves). Furthermore, the Specification does not define the term "transmission medium". The claimed "data stream" is clearly directed to intangible subject matter and an abstract concept. The claimed "frame" is also directed to nothing more than forms of data (e.g., packets of data or a defined group of data bits) as is understood in the art and acknowledged by Applicant (see Remarks filed 07/06/06). As such, although the preamble recites an apparatus, since the claimed limitations defining the apparatus are directed to intangible subject matter, the claims are non-statutory. Independent claim 53 is rejected using similar reasoning above.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 15-19, 21-27, 29-32, 49, 53, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (U.S. Pat. App. Pub. 2002/0059382),

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hereinafter referred to as Yamaguchi, and further in view of Kuzma (U.S. Pat. No. 5,771,355), hereinafter referred to as Kuzma.

9. Yamaguchi disclosed a method and system for managing access, via an electronic message, to a file maintained within a first domain, the system comprising means for identifying addresses of one or more recipients of the message (see paragraph [0052], [0068]) and designating each recipient as having viewing or editing privileges of the file (see paragraphs [0046], [0047], [0049], [0051], [0060], [0066], [0067], [0096]); and means for transmitting the electronic message to the recipients within one or more domains distinct from the first domain such that any recipients designated as file viewers and recipients designated as file editors can access the file, and any recipients designated as file editors can modify the file (see paragraph [0069], [0103]). Yamaguchi further disclosed a method and system comprising accepting one or more file accessor addresses (see paragraph [0052], [0068]); for each address, determining an authorization status as either authorized for direct file access or not authorized for direct file access (see paragraphs [0046], [0047], [0049], [0051], [0060], [0066], [0067], [0096]); transmitting the electronic message to the addresses within at least a second domain distinct from the first domain (see paragraph [0069], [0103]); and for each electronic message sent to a file accessor address not so authorized, transferring data of the file as an attachment to the electronic message (see paragraph [0069]).

10. While Yamaguchi disclosed transferring the electronic message to the recipients, Yamaguchi did not specifically disclose transmitting the electronic message without

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transferring the file out of the first domain with the electronic message. Yamaguchi did not specifically disclose for each electronic message sent to a file accessor address authorized for direct file access, transmitting data of the file separately from the electronic message.

11. In a related art of electronic messaging, Kuzma disclosed a method and system for transmitting e-mail over a network. Kuzma disclosed sending attachment files by reference, wherein the e-mail message itself comprised an attachment reference such as a hyperlink (see column 1, lines 59-61; column 5, lines 1-18; column 6, lines 17-33). Thus, Kuzma disclosed transmitting attachment data separately from an e-mail message.

12. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Yamaguchi and Kuzma to provide a system for identifying recipients of an electronic message as having viewing/editing privileges, transmitting the electronic message to the recipients without transferring the file with the electronic message as claimed. The invention of Yamaguchi generally related to the transfer of e-mail attachments to multiple recipients over a network. Kuzma similarly recognized this possibility (see column 5, lines 29-34), and also a problem associated with such a transfer as being costly and inefficient on network resources (see column 1, lines 36-52; column 3, lines 47-62; column 4, lines 52-67). The disclosed method of transmitting an attachment separately from an e-mail was described by Kuzma as a way of overcoming this problem, offering more efficient use of network resources (see column 6, lines 3-7), and would have motivated one of ordinary skill in the art to

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consider incorporating such a feature in the invention of Yamaguchi for its added benefits. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Yamaguchi and Kuzma to provide a system for displaying an e-mail message window comprising a plurality of recipients fields for recording which recipient addresses were authorized to view an attachment or edit the attachment, including the provision for transmitting the attachment separately from the e-mail message as claimed. The invention of Yamaguchi generally related to the transfer of e-mail attachments to multiple recipients over a network. Kuzma similarly recognized this possibility (see column 5, lines 29-34), and also a problem associated with such a transfer as being costly and inefficient on network resources (see column 1, lines 36-52; column 3, lines 47-62; column 4, lines 52-67). The disclosed method of transmitting an attachment separately from an e-mail was described by Kuzma as a way of overcoming this problem, offering more efficient use of network resources (see column 6, lines 3-7), and would have motivated one of ordinary skill in the art to consider incorporating such a feature in the invention of Yamaguchi for its added benefits.

***Allowable Subject Matter***

13. Claims 20, 33, 37, 38, and 50-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
14. Claims 1-14 and 44-48 are allowed.

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15. The following is an examiner's statement of reasons for allowance:

16. The closest prior art is Yamaguchi et al. (U.S. Pat. App. Pub. 2002/0059382), hereinafter referred to as Yamaguchi, and Kuzma (U.S. Pat. No. 5,771,355). The prior art references of record do not teach alone or in combination all the limitations together within the independent claims. For example, the independent claims 1 and 14 require the provision for an electronic message window including a first, second, and third field, accepting addresses in the first field to which the message is to be transmitted, and either or both accepting addresses in the second field identifying authorized viewers for a file referenced by the message or accepting addresses in the third field identifying authorized editors for the file, transmitting the message to the address in the first field and in response to a request to access the file by a recipient, authorizing the user to view or modify the file based on authorization data stored during the accepting of addresses into the various fields. Yamaguchi disclosed a means for identifying addresses of one or more recipients of the message (see paragraph [0052], [0068]) and designating each recipient as having viewing or editing privileges of the file (see paragraphs [0046], [0047], [0049], [0051], [0060], [0066], [0067], [0096]), but did not disclose a first, second, and third field for generating authorization data used to authorize a requesting user for viewing or modifying a file as claimed. Therefore, the independent claims 1 and 14 have allowable subject matter and are allowable over the prior art of record. The dependent claims of these claims are also allowable. Support for this functionality can be found in the Specification, p. 22, paragraphs [0075]-[0091], Fig. 4 and 5.



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17. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Response to Arguments***

18. Applicant's arguments filed 11/07/06 have been fully considered but they are not persuasive.

19. Regarding claims 26 and 27 rejected under 35 U.S.C. 101, Examiner acknowledges Applicant's amendment to the claims in overcoming the rejections made on the basis that claimed subject matter directed to propagate signals is non-statutory. However, as detailed above, the recited "transmission medium" and "data stream" are clearly directed to intangible subject matter and non-statutory. A transmission medium as is commonly known in the art can be electromagnetic signals, carrier waves, or other forms of intangible media. Furthermore, such a term is not limited to hardware by the Specification, as no instance of "transmission medium" can be found therein. Additionally, the claimed data stream comprised of data frames is directed to a mere arrangement of data, which is characterized as non-functional descriptive material. Therefore, as a whole, the invention recited in claims 26 and 27 is directed to non-statutory subject matter. Newly presented claims 53 and 54 also claim substantially the same invention using similar claim language, and are thus rejected using the same reasoning.

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20. Regarding claims 15-19, 21-27, 29-32, 49, 53, and 54 rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi in view of Kuzma, Examiner submits that the references read on the claims as presented. Absent any substantial argument from Applicant, Examiner notes for the record that as presented, the claim language in general requires a means for designating each recipient of an e-mail as having viewing or editing privileges of an attached file (see independent claim 15), a message window accepting addresses into a viewer field and editor field for generating authorization data signifying the privileges of each recipient of an e-mail for accessing an attached file (see independent claims 16 and 22), indicia designating addresses entered into a message recipient field as associated with message recipients having viewing or editing privileges of a file (see independent claim 25), and accepting an authorization status for each address in an e-mail message for authorizing access to an attached file (see independent claims 29 and 49), all of which is taught by the prior art references. As currently presented and/or currently amended, the scope of the claims is such that the breadth allows for the prior art of record to read upon the claimed limitations. For example, Yamaguchi discloses "means for identifying addresses of one or more recipients of the message and designating each recipient as having viewing or editing privileges of the file" (see paragraph [0052]), a message window containing fields and generating authorization data (see paragraphs [0041], [103]), thereby accepting an indicia or authorization status for each address in an e-mail for authorizing access to an attached file as claimed (see paragraphs [0046], [0047], [0049], [0051], [0060], [0066], [0067], [0096]). Additionally, Kuzma discloses sending attachment files by reference

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(i.e., separately), such as by a hyperlink contained within the e-mail (see column 1, lines 59-61; column 5, lines 1-18; column 6, lines 17-33). For this reason, claims 15-19, 21-27, 29-32, 49, 53, and 54 are rejected over the prior art of record.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fujiyoshi (U.S. Pat. No. 6,920,482)

Prust (U.S. Pat. No. 6,735,623)

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

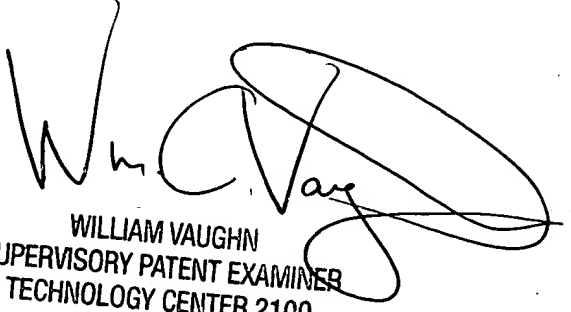
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM

  
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